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APPLICATION NO.	FILING DATE	FIRST NAMED INVENTOR	ATTORNEY DOCKET NO.	CONFIRMATION NO.
10/004,207	11/01/2001	Jose Fernandez	6021.026-CONT.	6367

25546 7590 07/11/2003

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EXAMINER

PRIDDY, MICHAEL B

ART UNIT	PAPER NUMBER
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3732

DATE MAILED: 07/11/2003

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Please find below and/or attached an Office communication concerning this application or proceeding.

**Office Action Summary**

Application N .

10/004,207

Applicant(s)

FERNANDEZ ET AL.

Examiner

Michael B Priddy

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-- The MAILING DATE of this communication appears on the cover sheet with the correspondence address --

**Period for Reply**

A SHORTENED STATUTORY PERIOD FOR REPLY IS SET TO EXPIRE 3 MONTH(S) FROM THE MAILING DATE OF THIS COMMUNICATION.

- Extensions of time may be available under the provisions of 37 CFR 1.136(a). In no event, however, may a reply be timely filed after SIX (6) MONTHS from the mailing date of this communication.
- If the period for reply specified above is less than thirty (30) days, a reply within the statutory minimum of thirty (30) days will be considered timely.
- If NO period for reply is specified above, the maximum statutory period will apply and will expire SIX (6) MONTHS from the mailing date of this communication.
- Failure to reply within the set or extended period for reply will, by statute, cause the application to become ABANDONED (35 U.S.C. § 133).
- Any reply received by the Office later than three months after the mailing date of this communication, even if timely filed, may reduce any earned patent term adjustment. See 37 CFR 1.704(b).

**Status**

- 1) ☐ Responsive to communication(s) filed on \_\_\_\_.
- 2a) ☐ This action is **FINAL**. 2b) ☒ This action is non-final.
- 3) ☐ Since this application is in condition for allowance except for formal matters, prosecution as to the merits is closed in accordance with the practice under *Ex parte Quayle*, 1935 C.D. 11, 453 O.G. 213.

**Disposition of Claims**

- 4) ☒ Claim(s) 1-65 is/are pending in the application.
- 4a) Of the above claim(s) \_\_\_\_ is/are withdrawn from consideration.
- 5) ☐ Claim(s) \_\_\_\_ is/are allowed.
- 6) ☐ Claim(s) 1, 3-9, 13, 18-20, 24, 29, 30, 32, 36-40 and 44 is/are rejected.
- 7) ☐ Claim(s) 2, 10-12, 14-17, 21-23, 25-28, 31, 33-35, 41-43 and 45-63 is/are objected to.
- 8) ☐ Claim(s) \_\_\_\_ are subject to restriction and/or election requirement.

**Application Papers**

- 9) ☐ The specification is objected to by the Examiner.
- 10) ☐ The drawing(s) filed on \_\_\_\_ is/are: a) ☐ accepted or b) ☐ objected to by the Examiner.
- Applicant may not request that any objection to the drawing(s) be held in abeyance. See 37 CFR 1.85(a).
- 11) ☐ The proposed drawing correction filed on \_\_\_\_ is: a) ☐ approved b) ☐ disapproved by the Examiner.
- If approved, corrected drawings are required in reply to this Office action.
- 12) ☐ The oath or declaration is objected to by the Examiner.

**Priority under 35 U.S.C. §§ 119 and 120**

- 13) ☐ Acknowledgment is made of a claim for foreign priority under 35 U.S.C. § 119(a)-(d) or (f).
- a) ☐ All b) ☐ Some \* c) ☐ None of:
1. ☐ Certified copies of the priority documents have been received.
2. ☐ Certified copies of the priority documents have been received in Application No. \_\_\_\_.
3. ☐ Copies of the certified copies of the priority documents have been received in this National Stage application from the International Bureau (PCT Rule 17.2(a)).
- \* See the attached detailed Office action for a list of the certified copies not received.
- 14) ☐ Acknowledgment is made of a claim for domestic priority under 35 U.S.C. § 119(e) (to a provisional application).
- a) ☐ The translation of the foreign language provisional application has been received.
- 15) ☒ Acknowledgment is made of a claim for domestic priority under 35 U.S.C. §§ 120 and/or 121.

**Attachment(s)**

- 1) ☒ Notice of References Cited (PTO-892)
- 2) ☐ Notice of Draftsperson's Patent Drawing Review (PTO-948)
- 3) ☐ Information Disclosure Statement(s) (PTO-1449) Paper No(s) \_\_\_\_.
- 4) ☐ Interview Summary (PTO-413) Paper No(s). \_\_\_\_.
- 5) ☐ Notice of Informal Patent Application (PTO-152)
- 6) ☐ Other:

## **DETAILED ACTION**

### ***Oath/Declaration***

The oath or declaration is defective. A new oath or declaration in compliance with 37 CFR 1.67(a) identifying this application by application number and filing date is required. See MPEP §§ 602.01 and 602.02.

The oath or declaration is defective because:

It does not identify the mailing or post office address of each inventor. A mailing or post office address is an address at which an inventor customarily receives his or her mail and may be either a home or business address. The mailing or post office address should include the ZIP Code designation. The mailing or post office address may be provided in an application data sheet or a supplemental oath or declaration. See 37 CFR 1.63(c) and 37 CFR 1.76.

### ***Claim Objections***

Claims 13 and 14 are objected to because of the following informalities: in line 1 of claim 13, "section" should be --portion--. Appropriate correction is required.

Claims 45-63 are objected to because of the following informalities: in line 15 of claim 45, "section" should be --portion--. Appropriate correction is required.

### ***Claim Rejections - 35 USC § 102***

The following is a quotation of the appropriate paragraphs of 35 U.S.C. 102 that form the basis for the rejections under this section made in this Office action:

A person shall be entitled to a patent unless –

(e) the invention was described in (1) an application for patent, published under section 122(b), by another filed in the United States before the invention by the applicant for patent or (2) a patent

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granted on an application for patent by another filed in the United States before the invention by the applicant for patent, except that an international application filed under the treaty defined in section 351(a) shall have the effects for purposes of this subsection of an application filed in the United States only if the international application designated the United States and was published under Article 21(2) of such treaty in the English language.

Claims 1, 3, 4, 5, 7, 8, 13, 23, 24, 30, 32, 36 and 37 are rejected under 35

U.S.C. 102(e) as being anticipated by White (U.S. 6,428,578). White teaches a modular hip prosthesis comprising a proximal segment 22, said proximal segment 22 including a neck 44 lockingly engageable with a femoral head component, said proximal segment 22 further including a male tapered portion 16 extending distally of said neck 44; a distal segment 30 having a proximal end 41 and a distal tip 37, a generally circular transverse cross section, said distal segment 30 including a male tapered portion 31 formed on an extension member 16 adjacent to said proximal end 41 thereof and a bone engaging outer surface portion; and a metaphyseal segment 14 having a proximal end 15 and a distal end 17, said metaphyseal segment 14 further including an axial bore 18 therethrough, said axial bore including first (at the proximal end) and second (at the distal end) female tapered portions, said first female tapered portion located adjacent to said proximal end of said metaphyseal segment 14 and dimensionally configured to lockingly engage said male tapered portion 31 of said proximal segment 22, said second female tapered portion located adjacent to said distal end 17 of said metaphyseal segment 14 and dimensionally configured to lockingly engage said male tapered portion 31 of said distal segment 30. Finally, in lines 42-43 of column 6, White mentions that the "distal shaft 30 could be coated, fluted, slotted or the like."

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***Claim Rejections - 35 USC § 103***

The following is a quotation of 35 U.S.C. 103(a) which forms the basis for all obviousness rejections set forth in this Office action:

(a) A patent may not be obtained though the invention is not identically disclosed or described as set forth in section 102 of this title, if the differences between the subject matter sought to be patented and the prior art are such that the subject matter as a whole would have been obvious at the time the invention was made to a person having ordinary skill in the art to which said subject matter pertains. Patentability shall not be negated by the manner in which the invention was made.

Claims 9, 18, 20, 29, 39 and 44 are rejected under 35 U.S.C. 103(a) as being unpatentable over White. White, as set forth in the above rejection under 35 U.S. C. 102(e), teaches all of the limitations of the present invention except said distal, proximal and metaphyseal segments being constructed from a material selected from the group consisting of titanium alloy, cobalt chromium alloy, and stainless steel.

It would have been obvious to one having ordinary skill in the art at the time the invention was made to form each of these segments of titanium alloy, cobalt chromium alloy or stainless steel, since it has been held to be within the general skill of a worker in the art to select a known material on the basis of its suitability for the intended use as a matter of obvious design choice. In re Leshin, 125 USPQ 416.

Claims 6, 19, 38 and 40 are rejected under 35 U.S.C. 103(a) as being unpatentable over White. White, as set forth in the above rejection under 35 U.S.C. 102(e) teaches all of the limitations of the present invention except the bone engaging surfaces of the metaphyseal and distal segments is selected from the group consisting of grit blasted finish, sintered metal bead coating, hydroxylapatite coating, plasma spray

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coating, bio-glass ceramic coating, demineralized bone and carrier and growth factor and carrier.

White (U.S. 5,902,340) teaches a method of assembling a modular prosthesis used for bone replacement which may take the form of a femoral component as shown in Fig. 3. In lines 35-39 of column 7, White ('340) suggests that "portions of the stem component and/or the body component may be highly polished or have a porous coating plasma spray, or hydroxylapatite coating... ..to promote new bone growth..." It would have been obvious to one of ordinary skill in the art at the time of the present invention to have provided a plasma spray coating on the metaphyseal and/or distal segments of the prosthesis of White ('578) to promote new bone growth and enhance the fixation of the prosthesis.

***Allowable Subject Matter***

Claims 2, 10-12, 15-17, 21-23, 25-28, 31, 33-35 and 41-43 are objected to as being dependent upon a rejected base claim, but would be allowable if rewritten in independent form including all of the limitations of the base claim and any intervening claims.

Claim 14 would be allowable if rewritten to overcome the objection for minor informalities as set forth in this Office action and to include all of the limitations of the base claim and any intervening claims.

Claims 45-63 would be allowable if rewritten or amended to overcome the objection for minor informalities as set forth in this Office action.

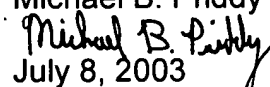
**Conclusion**

The prior art made of record and not relied upon is considered pertinent to applicant's disclosure. Itoman et al. (U.S. 6,190,41) has been cited to show the formation of grooves (flutes) on the distal end of a femoral prosthesis. Naybour (U.S. 6,200,349) has been cited to show slots formed in the distal end of a femoral prosthesis. Powell (U.S. 5,876,459) has been cited to show a similar modular femoral prosthesis.

Any inquiry concerning this communication from the examiner should be directed to Michael B. Priddy whose telephone number is (703) 308-8620. The examiner can normally be reached on Mon.-Fri. 8 a.m. - 5 p.m..

If attempts to reach the examiner by telephone are unsuccessful, the examiner's supervisor, Kevin Shaver can be reached on (703) 308-2582. The fax phone numbers for the organization where this application or proceeding is assigned are (703) 872-9302 for regular communications and (703) 872-9303 for After Final communications.

Any inquiry of a general nature or relating to the status of this application or proceeding should be directed to the receptionist whose telephone number is (703) 308-1148.

Michael B. Priddy  
  
July 8, 2003